REMARKS/ARGUMENTS

The amendment herein merely corrects typographical errors and does not present new matter.

All of the claims of this application are commonly owned.

The rejection of claims 55-67 as obvious over Richardson et al. is respectfully traversed, and reconsideration is requested. The reference has been cited for its disclosure of the manufacture of rubber articles, including surgical gloves, from latex by dip-molding followed by vulcanization in the presence of a vulcanizing agent. The examiner has correctly noted that the reference does not teach the method limitations recited in Applicants' claims, but has expressed the belief that there is no structural difference between the product resulting from the method and the product disclosed by the reference. The examiner has also stated that the process limitations in a product-by-process claim are generally not accorded any patentable weight and that product-by-process claims must contain structural limitations that are able to stand alone. Neither is correct.

According to MPEP § 2113 at page 2100-59:

> "The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product."

The two decisions that the examiner has cited are not on point and neither one supports the notion that process limitations in a product-by-process claim are not accorded patentable weight or that product-by-process claims must contain structural limitations that can stand alone. The claim in the *In re Casey* decision was directed to a machine that was recited in terms of how it was to be used rather than how it as made. The relevant statement made in the decision was "The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself." (Page 238) The same is true for the *In re Otto* decision, where the relevant statement was "...and Rishoi and the others indicate that inclusion of the material or article worked upon by a structure being claimed does not impart patentability

to the claims." (Page 459, emphasis added) Neither decision involved a product-by-process claim.

A more pertinent decision is that of *In re Hughes*, 182 USPQ 106 (Court of Customs and Patent Appeals, 1974), where actual product-by-process claims were before the court and deemed allowable. In that decision, the court states as follows:

> "When an applicant seeks to describe his invention by a product-by-process claim because he finds that his invention is incapable of description solely by structure or physical characteristics, it is incumbent upon the Patent Office to indicate where, or how, the applicant's invention is, or may be, so described."

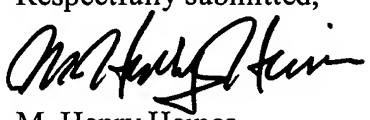
The examiner's statement that there is no structural difference between the claimed invention and the prior art is incorrect. While Richardson et al. offer no explanation of how vulcanization was performed on the dip-molded article, the vulcanization method used in the prior art for latex prior to Applicants' invention was heating by exposure to hot air. This is explained in the "Background of the Invention" section of the instant application in the paragraph beginning at page 1, line 22. The person skilled in the art reading the Richardson et al. reference will necessarily assume that article disclosed by the reference was vulcanized in hot air. The comparative test data in the instant specification shows that there is indeed a difference between dip-molded latex articles that are vulcanized in a hot liquid in accordance with the invention and those vulcanized by the hot air method and the prior art in general. Example 1 of the instant specification shows that dipped latex films prepared from organic peroxide formulated latices cannot be successfully cured in a hot air oven due to the interaction with the oxygen in the curing environment. Example 2 uses the same materials as Example 1 but shows that when they are vulcanized by contact with a molten salt solution, the results are successful, including an outstanding tensile strength. Example 7 compares the hot air cure of the prior art with a molten salt cure of the invention and shows that the latter produces a product with tensile properties that greatly exceed those of the former.

Collectively, these examples demonstrate that the product is itself different, and the Applicants are unable to characterize other than by the process by which they were produced. Accordingly, the process limitations in Applicants' claims merit full consideration in the

determination of patentability, and once this is done, the invention in the instant claims fully meets the requirements of patentability, including both novelty and nonobviousness. The rejection should therefore be withdrawn.

Should any matters remain that can be resolved by a telephone conference, the examiner is encouraged to telephone the undersigned at 415-576-0200.

Respectfully submitted,



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